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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/747,020	12/26/2000	Koichi Awano	001740	3284
23850 7590 06/01/2007 ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP 1725 K STREET, NW SUITE 1000 WASHINGTON, DC 20006			EXAMINER COLBERT, ELLA	
			ART UNIT 3694	PAPER NUMBER
			MAIL DATE 06/01/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/747,020	AWANO, KOICHI	
	Examiner	Art Unit	
	Ella Colbert	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, and 4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1, 2, and 4 are pending. Claim 4 has been amended in this communication filed 03/13/07 entered as Response After Non-Final Action.
2. The Objections to the Specification have been overcome by Applicant's amendment to the Specification and are hereby withdrawn.
3. The Drawings Objection has been overcome by Applicant's amendment to the Specification and is hereby withdrawn in part. An amendment in the Specification or Drawings has not been found for Figure 3 as set forth here below.
4. The 35 USC 112 second paragraph rejection for claim 1 has been overcome by Applicant's convincing arguments and is hereby withdrawn. However, the 35 USC 112 second paragraph rejection for claim 4 still remains as set forth here below.

### ***Drawings***

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 3, reference character(s) "A, D, And E". Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If

Art Unit: 3694

the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 is unclear in the claims, specification, and drawings why the card becomes invalid by performing the process in claim 4. Does the card become invalid because the amount remaining on the card is withdrawn leaving a zero balance or does some other event occur? Clarification in the claim language and the specification is respectfully requested in order for the Examiner to understand what event occurs making the card invalid by using the prepaid card at an ATM and making a cash withdrawal.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3694

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1, 2, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,012,635) Shimada et al, hereafter Shimada and (US 6,473,500 B1) Risafi et al, hereafter Risafi in view of (US 6,003,762) Hayashida.

As per claim 1, Shimada discloses, A card settlement system using a debit card comprising: means for using a debit card having an identification number and a money withdrawal function to issue a prepaid card after the identification number of the debit card is checked to see if the debit card is forged or stolen (col. 9, line 15-27). Shimada failed to disclose, means for transmitting settlement data corresponding to a price or charge to be paid by using said prepaid card from a store's bank with which a prepaid card usable store has an account to a settlement bank in which said prepaid card is issued. Risafi discloses, means for transmitting settlement data corresponding to a price or charge to be paid by using said prepaid card from a store's bank with which a prepaid card usable store has an account to a settlement bank in which said prepaid card is issued (col. 13, lines 53-62). Shimada and Risafi failed to disclose, means for

Art Unit: 3694

remitting from said settlement bank to a store's account in said store's bank on the basis of said settlement data. Hayashida discloses, means for remitting from said settlement bank to a store's account in said store's bank on the basis of said settlement data (col. 5, lines 51-61, col. 8, line 56- col. 9, line 23). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a means for remitting from said settlement bank to a store's account in said store's bank on the basis of said settlement data and to modify in Shimada because such a modification would allow Shimada to have an ATM terminal unit that writes the information about the amount the owner transfers between his bank deposit account and the multi-function IC card and to consummate the processing of the settlement data.

As per claim 2, Shimada failed to disclose, The card settlement system according to Claim 1, wherein said prepaid card does not store an amount of money having a cash function but stores credit grant information indicative of a usable amount. Risafi discloses, The card settlement system according to Claim 1, wherein said prepaid card does not store an amount of money having a cash function but stores credit grant information indicative of a usable amount (col. 13, lines 19-62). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have said prepaid card to not store an amount of money having a cash function but stores credit grant information indicative of a usable amount and to modify in Shimada because such a modification would allow Shimada to provide a card that is more flexible than the cards typically available today.

As per claim 4, Shimada discloses, A card settlement system using a debit card including an ATM of a settlement bank, said ATM comprising: means for using a debit card having an identification number and a money withdrawal function to issue a prepaid card after the identification number of the debit card is checked to see if the debit card is forged or stolen (col. 9, lines 15-27). Risafi discloses, means for inserting a prepaid card having a balance into said ATM (col. 13, line 63-col. 14, line 19); means for inputting an identification number for the prepaid card (col. 14, lines 37-55) and means for withdrawing cash using the prepaid card (see abstract, col. 13, line 62-col. 14, line 19).

Shimada and Risafi failed to disclose, means for processing the withdrawal of cash when said identification number of the prepaid card is proper and making the processed prepaid card invalid. Hayashida discloses means for processing the withdrawal of cash when said identification number of the prepaid card is proper making the processed prepaid card invalid (col. 9, line 63-col. 10, line 20 and col. 12, lines 27-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a means for processing the withdrawal of cash when said identification number of the prepaid card is proper and making the processed prepaid card invalid and to modify in Shimada because such a modification would allow Shimada to have the capability to perform a validity check on the card to permit the execution of a normal processing.

### ***Response to Arguments***

10. Applicant's arguments filed 03/13/07 have been fully considered but they are not persuasive.

Issue no. 1: Applicant argues: Applicant respectfully disagrees that the cited passage discloses checking the validity data of a prepaid card but fails to disclose: using the debit card to issue a prepaid card, as claimed in the instant application; or checking to see if the debit card is forged or stolen, as claimed in the instant application has been considered but is not persuasive. Response: The Examiner interprets checking the validity of the debit card as a means of checking whether the debit card is forged or stolen. If the card is determined to be invalid that is a good indication that the debit card is forged or stolen.

Issue no. 2: Applicant argues: Applicant respectfully disagrees that Risafi et al discloses only the purchase of a prepaid card, but does not disclose using the debit card to issue a prepaid card has been considered but is not persuasive. Response: Shimada was used to disclose this claim limitation and not Risafi et al.

Issue no. 3: Applicant argues: Hayashida fails to disclose a card settlement system using a debit card to issue a prepaid card as claimed in the present invention has been considered but is not considered persuasive. Response: A card settlement system using a debit card to issue a prepaid card is not found in the body of claim 4.

The recitation "a card settlement system" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble



Art Unit: 3694

for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Flitcroft et al (US 2003/0028481- continuation application 09/235,836 filed 01/22/99) disclosed a credit card system that can be used for a limited-use transaction.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


### **Inquiries**

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Wednesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

May 24, 2007

  
ELLA COLBERT  
PRIMARY EXAMINER